

### **REMARKS**

The foregoing amendment and the following arguments are provided generally to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

Claims 1-5, 7-14, 16-20, 22-29 and 31-45 were rejected. Applicant respectfully disagrees. Claims 1, 9-10 and 13 are amended. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. No new matter has been added.

#### **Rejections Under 35 U.S.C. §103(a)**

Claims 1-5, 7-14, 16-20, 22-29 and 31-44 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,807,532 ("Kolls"), in view of U.S. Patent No. 6,216,111 ("Walker"). Claim 45 is rejected under U.S.C. §103(a) as being unpatentable over Kolls, in view of Walker, and further in view of U.S. Patent No. 6,323,894 ("Katz"). Applicant respectfully disagrees.

Applicant respectfully submits that the rejection was based upon impermissible hindsight afforded by the claimed invention, not based upon the disclosure of the cited reference.

MPEP 2141.II provides:

"When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined."

"The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight

must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” (See, e.g., MPEP 2142)

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Applicant respectfully submits that the combinations suggested in the Office Actions are not based on the suggestion or teaching provided in the cited reference. In view of the disclosure of the cited references, the combinations suggested in the Office Action would appear strange to an ordinary person; and thus, the suggested combination would fail the standard of “reasonable expectation of success”. A detailed discussion is provided below.

Kolls discloses a system to display an advertisement, such as a system 500 with a phone. A user can response to the advertisement displayed on the system 500 (e.g., by touching the advertisement) to cause the system to dial a preset phone number. In an example provided in Kolls, when the advertisement is for a local restaurant, the system dials the phone number of the restaurant so that the user can speak to the restaurant host.

Walker discloses a system for telemarketing, in which a recorded sales presentation is provided during the telemarketing call. The system of Walker asks automated questions to verify that the consumer actually paid attention to listen to the sales presentation. A live agent may be signaled to ask follow-up questions.

The phone call made by the user according to Kolls is clearly not a telemarketing call. The user is to be connected to the advertiser (e.g., the restaurant host to make arrangement to visit the restaurant), not to a telemarketer for a sales presentation.

Thus, the disclosure of Walker related to telemarketing is not applicable.

Further, the combinations suggested in the Office Action appears strange. After a customer reads the advertisement displayed on the system 500 of Kolls, it would appear unnecessary to have the customer to listen again to a recorded sales presentation. It would appear unreasonable to an ordinary person that the customer would read the advertisement displayed on the system of Kolls and then select the advertisement to listen to a telemarketing recording and then answer automated questions to verify that the customer actually listened.

Since the combination is clearly not based on the teaching of Kolls and Walker, Applicant respectfully asserts that the rejection is based on impermissible hindsight afforded by the claimed invention.

Thus, the withdrawal of the rejections is respectfully requested.

In rejecting claim 45, the Office Action relied upon the disclosure of Katz related to video conferencing for interactive training sessions or seminars.

Applicant respectfully submits that **training** sessions (or seminars) are not telemarketing calls. Typically, a person pays a fee for being trained. Thus, the disclosure of Walker related to telemarketing is not applicable to Kolls and Katz, when the disclosure of the cited references are viewed as a whole. Since the combination is clearly not based on the teaching of Kolls, Walker and Katz, Applicant respectfully asserts that the rejection is based on impermissible hindsight afforded by the claimed invention.

The Office Action asserted that “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Kolls would allow ...”. Applicant respectfully disagrees. The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Applicant respectfully requests the evidence that would support the assertion of alleged knowledge in the field. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

**CONCLUSION**

It is respectfully submitted that all of the Examiner's objections have been successfully traversed and that the application is now in order for allowance. Accordingly, reconsideration of the application and allowance thereof is courteously solicited.

Respectfully submitted,

Date: December 22, 2006

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